Docket No.: 6281-000028/US/NP
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kurt Lappe

Application No.: 10/579,278 Confirmation No.: 8252

Filed: February 13, 2007 Art Unit: 2854

For: Method and Device for Combined Printing Examiner: Leo T. Hinze

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on June 9, 2011, and is in furtherance of said Notice of Appeal.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Kurt Lappe.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 18 claims pending in the application.

B. Current Status of Claims

1. Claims canceled: 4, 6, 8, 10-17, 21, 26,
2. Claims withdrawn from consideration but not canceled: n/a
3. Claims pending: 1-3, 5, 7, 9, 18-20, 22-25, and 27-31
4. Claims allowed: n/a
5. Claims rejected: 1-3, 5, 7, 9, 18-20, 22-25, and 27-31

C. Claims On Appeal

The claims on appeal are Claims 1-3, 5, 7, 9, 18-20, 22-25, and 27-31.

IV. STATUS OF AMENDMENTS

On July 5, 2011, Applicant filed an Amendment pursuant to 37 C.F.R. § 41.33 to place the application in better condition for appeal and comply with a requirement of form expressly set forth in the Final Action. Specifically, Applicant amended Claim 27 to reflect that Claim 19, from which Claim 27 depends, is an apparatus claim. The claims in Appendix A of this Appeal Brief incorporate the amendments made in Applicant's July 2nd Amendment, as well as all previous amendments made during prosecution.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Applicant's claimed invention generally provides for a method and apparatus for producing print products on a substrate, each of the print products include the following vertically aligned on the substrate: a transfer layer, a print, and an embossing. The method is performed successively and continuously in an in-line production process without interruption. This is generally made possible by an active drying step with a drying unit, which dries glue of the transfer layer prior to embossing or printing, or dries ink of the print prior to embossing or transfer of the transfer layer. Prior to Applicant's invention, forming such print products required stopping production so that the glue or ink had time to dry by air drying, thereby increasing production time and cost.

Pursuant to 37 C.F.R. § 41.37(v), a concise explanation of the subject matter claimed in each independent claim is provided below that refers to the specification by page and line number, and to the drawing. The specification citations are to the U.S. Published Application (2007/0234919) for ease of reference because it includes paragraph numbers, and to the drawings by reference numbers. The citations are for exemplary purposes only.

Claim 1

Independent Claim 1 recites a method for the production of print products by combining various immediately successive processing methods, the method comprising the steps of:

Claim Features	Exemplary Specification Citation
partially coating less than an entirety of a base material with an adhesive at predetermined positions of the base material corresponding to intended	Base material: Figs. 1-3, 5, & 6; ref. no. 2. Adhesive: Figs. 5 and 6; ref. no. 3. Print Products: Fig. 6; ref. no. 22.

locations of the print products;	Fig. 6, ¶ [0050] at lines 1-5; ¶ [0063] at lines 7-15.
providing a transfer film including a carrier foil layer, a parting layer, and a transfer layer;	Transfer film: Figs. 1-3 & 5; ref. no. 10. Carrier foil layer: Figs. 5, 6; ref. no. 18. Parting layer: Figs. 5, 6; ref. no. 19. Transfer layer: Figs. 1-3 & 5; ref. no. 20. Figs. 5,6; ¶ [0062] at lines 1-7.
removing said transfer layer from said carrier foil and transferring less than an entirety of the transfer layer to the base material exclusively at the predetermined positions of the base layer by adhering the transfer layer to the adhesive;	Figs. 5, 6, ¶ [0062] at lines 9-15; ¶ [0063] at lines 7-15; ¶ [0065] at lines 12-18.
providing an embossing at the predetermined positions of the base material;	Figs. 1-3; ¶¶ [0055]-[0056], [0059], [0067].
providing a color printing at the predetermined positions of the base material one of before or after coating the base material with an adhesive; and	Figs. 1-3; ¶ [0054] at lines 24-35; ¶ [0058] at lines 1-11; ¶ [0060] at lines 4-6, and 10-11.
actively drying with a drying device one of the adhesive or the color printing;	Drying device: Figs. 1-3; ref. no. 26. Figs. 1-3; ¶ [0054] at lines 13-24, ¶ [0058] at lines 11-15, ¶ [0060] at lines 10-11.
wherein the print products to be produced successively undergo the steps of the method in one continuous sequence without intermediate storage; and	Figs. 1-3; ¶ [0054] at lines 20-24; ¶ [0065] at lines 3-5; abstract; original Claim 1.
wherein at each predetermined position on the substrate the transferred portion of the transfer layer, the color printing, and the embossing overlap and are positioned in stacked vertical alignment with respect to the base material.	¶ [0067], abstract, Fig. 6.

Claim 18

Independent Claim 18 recites a method for producing a print product, the method comprising:

Claim Features	Exemplary Specification Citation
coating a base layer with an adhesive layer exclusively at predetermined positions of the base layer corresponding to desired locations of the print products;	Base layer: Figs. 1-3, 5, and 6; ref. no. 2. Adhesive layer: Figs. 5 and 6; ref. no. 3. Print Products: Fig. 6; ref. no. 22. Fig. 6, ¶ [0050] at lines 1-5; ¶ [0063], at lines 7-15.
providing a transfer film including at least a carrier foil layer, a parting layer, and a transfer layer;	Transfer film: Figs. 1-3 & 5; ref. no. 10. Carrier foil layer: Figs. 5, 6; ref. no. 18. Parting layer: Figs. 5, 6; ref. no. 19. Transfer layer: Figs. 1-3 & 5; ref. no. 20. Figs. 5,6; ¶ [0062] at lines 1-7.
transferring portions of the transfer layer to said base layer exclusively at the predetermined positions including the adhesive;	Figs. 5, 6, ¶ [0062] at lines 9-15; ¶ [0063] at lines 7-15; ¶ [0065] at lines 12-18.
embossing the base layer at the predetermined positions of the base layer one of before or after coating the base layer with the adhesive layer;	Figs. 1-3; ¶¶ [0055]-[0056], [0059], [0067].
printing the base layer with a print at the predetermined positions of the base layer one of before or after coating the base layer with the adhesive layer; and	Figs. 1-3; ¶ [0054] at lines 24-35; ¶ [0058] at lines 1-11; ¶ [0060] at lines 4-6, and 10-11.
actively drying one of the adhesive or the print in a drying unit;	Drying unit: Figs. 1-3; ref. no. 26. Figs. 1-3; ¶ [0054] at lines 13-24, ¶ [0058] at lines 11-15, ¶ [0060] at lines 10-11.
wherein the method is performed successively and continuously without intermediate storage; and	Figs. 1-3; ¶ [0054] at lines 20-24; ¶ [0065] at lines 3-5; abstract; original Claim 1.
wherein at each predetermined position	¶ [0067], abstract, Figure 6.

the adhesive, the transfer layer, the print, and the embossing are in overlapping, vertical alignment with respect to the base layer.	

Claim 19

Independent Claim 19 recites a combined in-line printing apparatus comprising:

Claim Features	Exemplary Specification Citation
a gluing unit configured to selectively apply an adhesive to a plurality of predetermined positions of a base printing material fed through said printing apparatus, each one of the predetermined positions corresponding to a desired location of a print product on the base printing material;	Gluing unit: Figs. 1-3; ref. no. 1. Adhesive: Figs. 5 and 6; ref. no. 3. Base printing material: Figs. 1-3, 5, 6; ref. no. 2. Print product: Fig. 6; ref. no. 22. Fig. 6, ¶ [0050] at lines 1-5; ¶ [0063], at lines 7-15.
a stamping device configured to form a pattern in said base material exclusively at each of the predetermined positions, the pattern including at least one of elevations or indentations;	Stamping device: Figs. 1-3; ref. no. 33. Figs. 1-3; ¶¶ [0055]-[0056], [0059], [0067].
a film transfer device configured to transfer a transfer layer of a transfer film to said base material exclusively at the predetermined positions to which the adhesive has been previously applied, said transfer film having at least a carrier foil layer, a parting layer, and said transfer layer;	Film transfer device: Figs. 1-3; ref. no. 7. Transfer layer: Figs. 1-3 & 5; ref. no. 20. Transfer film: Figs. 1-3 & 5; ref. no. 10. Carrier foil layer: Figs. 5 and 6; ref. no. 18. Parting layer: Figs. 5 and 6; ref. no. 19. Transfer layer: Figs. 1-3; ref. no. 20. Figs. 5, 6, ¶ [0062] at lines 9-15; ¶ [0063] at lines 7-15; ¶ [0065] at lines 12-18.
a printing device configured to print a material exclusively at the predetermined positions of said base material;	Printing device: Figs. 1-3; ref. no. 29. Figs. 1-3; ¶ [0054] at lines 24-35; ¶ [0058] at lines 1-11; ¶ [0060] at lines 4-6, and 10-11.
a drying unit configured to actively dry said adhesive; and	Drying unit: Figs. 1-3; ref. no. 26. Figs. 1-3; ¶ [0054] at lines 13-24, ¶ [0058]

	at lines 11-15, ¶ [0060] at lines 10-11.
a pressing unit having a plurality of calenders configured to compress said base layer and said transfer layer;	Pressing unit: Figs. 1-3; ref. no. 8. Figs. 1-3; ¶¶ [0053], [0064].
wherein said base layer interacts with said gluing unit, said stamping device, said film transfer device, and said printing device without intermediate storage to provide the adhesive, the transfer film, the pattern, and the print material in overlapping vertical alignment on the base printing material at each of the predetermined portions.	Figs. 1-3; ¶ [0054] at lines 20-24; ¶ [0065] at lines 3-5; ¶ [0067]; abstract; original Claim 1.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether independent Claims 1, 18, and 19, as well as those claims dependent therefrom, are unpatentable under 35 U.S.C. § 103(a) as obvious by the combination of Gross et al. (U.S. Pat. No. 5,603,259) in view of Vaughn et al. (U.S. Pat. No. 6,983,686).

2. Whether dependent Claim 2 is unpatentable under 35 U.S.C. § 103(a) as obvious by the combination of Gross et al. in view of Vaughn et al.

3. Whether dependent Claim 20 is unpatentable under 35 U.S.C. § 103(a) as obvious by the combination of Gross et al. in view of Vaughn et al.

4. Whether dependent Claim 22 is unpatentable under 35 U.S.C. § 103(a) as obvious by the combination of Gross et al. in view of Vaughn et al.

5. Whether dependent Claim 23 is unpatentable under 35 U.S.C. § 103(a) as obvious by the combination of Gross et al. in view of Vaughn et al.

6. Whether dependent Claims 24 and 27 are unpatentable under 35 U.S.C. § 103(a) as obvious by the combination of Gross et al. in view of Vaughn et al.

VII. ARGUMENT

A. Combination of Gross et al. and Vaughn et al. Fails to Render Obvious Under 35 U.S.C. § 103 Independent Claims 1, 18, and 19, as well as those Claims Dependent Therefrom

Independent Claims 1, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gross et al. (U.S. Pat. No. 5,603,259) in view of Vaughn et al. (U.S. Pat. No. 6,983,686). For the reasons set forth below, Applicant respectfully submits that this combination is not proper and fails to render the claims obvious.

1. Teachings of Claim 1

Independent Claim 1 recites, in part, the following:

- "***actively drying*** with a drying device one of the adhesive or the color printing;"
- "wherein the print products to be produced ***successively undergo*** the steps of the method in one continuous sequence ***without intermediate storage***;" and
- "wherein at each predetermined position on the substrate the transferred portion of the ***transfer layer***, the ***color printing***, and the ***embossing overlap*** and are positioned in ***stacked vertical alignment*** with respect to the base material" (emphasis added).

2. Teachings of Claim 18

Independent Claim 18 recites, in part, the following:

- "***actively drying*** one of the adhesive or the print in a drying unit;"
- "wherein the method is performed ***successively and continuously without intermediate storage***;" and
- "wherein at each predetermined position the adhesive, the ***transfer layer***, the ***print***, and the ***embossing*** are in ***overlapping, vertical alignment*** with respect to the base layer" (emphasis added).

3. Teachings of Claim 19

Independent Claim 19 recites, in part, the following:

- "a ***drying unit*** configured to actively dry said adhesive;"
- "wherein said base layer interacts with said gluing unit, said stamping device, said film transfer device, and said printing device without intermediate storage to provide the adhesive, the ***transfer film***, the ***[stamped] pattern***, and the ***print material*** in ***overlapping vertical alignment*** on the base printing material at each of the predetermined portions" (emphasis added).

4. Background of the Invention and Technical Field

Applicant's invention, particularly as set forth in Claims 1, 18, and 19, solved numerous long-felt needs, overcame a number of technical obstacles, and includes many novel features that provide advanced printing capabilities. For example, prior to Applicant's invention it was not possible to provide a transfer film, a color print, and an embossing in stacked vertical alignment on a substrate in one continuous sequence without intermediate storage of the substrate, as generally claimed. Rather, manufacturing had to be stopped after the transfer film adhesive and/or the color printing was deposited on the substrate to give the adhesive or printing adequate time to dry.

For example and as set forth in Applicant's specification, in the embodiment of Figure 1 the adhesive layer 3 (Figure 5) with the transfer film mounted thereto should be dry prior to embossing or printing. *See* p. 15, ¶ 2; p. 16, ¶ 1. With respect to the embodiment of Figure 2, the base layer 2 and any material printed thereon should be dry to "assure a correct application of the adhesive agent 3 and a subsequent application of the transfer layer." *See* page 16, ¶ 4. Applicant's claimed in-line drying step and the active drying device 26 eliminate the need to subject the substrate to an

intermediate storage step to dry the adhesive. Such a storage step is time consuming (particularly because air drying is often employed) and increases production costs by limiting the number of print products that can be produced during a given production period.

By actively drying the adhesive or the color print in-line with a drying unit, Applicant has been able to fulfill a long-felt need in the art to provide for production of print products in a continuous sequence without intermediate storage, the print products including each of the following in overlapping, stacked vertical alignment: (1) a transfer layer; (2) color printing; and (3) embossing.

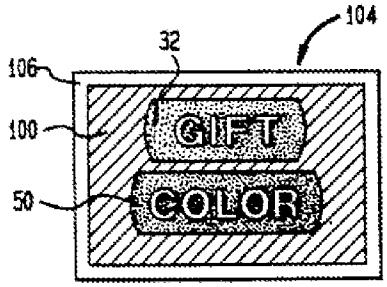
5. Teachings of the Gross et al. Reference

The Gross reference appears to disclose a printing device that includes a first printing station 14 where a first word is printed in color, such as "COLOR." The letters are recessed within raised area 44 on roller 38 so that the letters of "COLOR" are not colored, but the surrounding area is. A second printing station 16 is similar to the first printing station in order to print a second word, such as "GIFT." An adhesive is applied at a third printing station 18. A roller 74 of the third station 18 includes inner indentations 82 and 84 at areas corresponding to the previously printed words and a surrounding raised area 80. Thus, the adhesive is applied only to the area surrounding the printed words.

After the adhesive is applied, it is heated to initiate a curing process, which continues under "ambient conditions." *See* col. 5, lines 1-4. At transfer station 24, a metallic layer 98 is transferred to the adhesive 68 from the roll leaf 90. After exiting the transfer station 24, "[t]he adhesive curing process, which was initiated at the heating

station 20, now continues on each piece under *ambient conditions*." *See* col. 5, lines 26-34 (emphasis added). The finished product is below.

FIG. 3



The words "GIFT" and "COLOR" are not colored and not printed in ink, but rather outlined by the ink layers 32 and 50 respectively. A metalized design 100 surrounds the ink patterns where the adhesive was previously applied. A non-metalized outer border 106 is also included.

The Final Action asserted that Gross discloses an overlapping transfer layer and color printed layer. *See* 3-15-2011 Final Action at 1st line of page 6 ***But this is clear error*** – there is NO overlap as illustrated in Figure 3 and explained above. Gross thus fails to disclose or suggest vertically aligning a transfer layer and color print layer, as generally claimed. Gross also fails to disclose or suggest ***embossing or a structure including elevations and/or indentations*** as claimed; Gross only discloses processing a flat web, as acknowledged in the Final Action at page 6. Further, Gross fails to disclose or suggest active drying of the adhesive after the roll leaf 90 is transferred. Instead, the adhesive curing process continues under "ambient conditions."

6. Teachings of the Vaughn et al. Reference

The Vaughn reference appears to disclose a device for providing a substrate with embossed images 20 and printed images 30, which may "overlap, resulting in a

synergistic visual interaction between the two images, or where the two images are separated from each other." *See* col. 3, lines 37-40. Vaughn fails to disclose or suggest either applying a transfer film to the substrate or active drying. Vaughn thus fails to disclose or suggest vertically aligning on a substrate all three of (1) a transfer film, (2) an embossing (or a pattern with elevations or indentations), and (3) a printing, as generally set forth in amended independent Claims 1, 18, and 19.

Vaughn's teachings are limited to a continuous stretchable substrate (*see* col. 2, line 52; col. 3, lines 19-26). Embossed elevations and/or indentations, such as disclosed and generally claimed by Applicant, cannot be maintained in such a stretchable substrate because it has a spring force that will remove the structure. Vaughn's substrate will therefore remain continuously flat, which is supported by the fact that Vaughn does not disclose embossing that provides elevations or indentations, but only a flat "disruption" of the structure of the substrate (col. 5, lines 8-12), which is simply a type of watermark. This is why embossing can take place before printing (Figure 1 of Vaughn). Otherwise, the use of printing rollers (ref. nos. 31, 32), which are not disclosed as having a gap therebetween, would destroy the elevations or indentations. Such an embossed "disruption" provides an uneven surface to which it would be very difficult, if not impossible, to secure a transfer layer to.

7. Combination of Gross and Vaughn is Improper and Fails to Render Obvious Independent Claims 1, 18, and 19

The 35 U.S.C. § 103 rejection is improper because it relies on an incorrect factual basis and one skilled in the art would not have been motivated to combine and

modify the Gross and Vaughn references as asserted in the Office Action. As sole basis for the combination, the Examiner stated as follows:

> It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gross to provide an embossing at the predetermined positions of the base material, because Vaughn teaches that one can predictably print and emboss a substrate in vertically stacked alignment, and embossing is advantageous for enhancing the aesthetics of consumer products.

See 3-15-2011 Final Action at 6, 9, and 11.

The proposed combination of Gross and Vaughn is improper because the Examiner is inappropriately relying on speculation, unfound assumptions, hindsight reconstruction, and "common knowledge without evidentiary support in the record." *In re Warner*, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967); MPEP § 2144.03 (*citing In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001)). Even if Gross could be modified as asserted by the Examiner, the modifications are not obvious because the prior art failed to suggest their desirability. *In re Mills*, 916 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1990).

For example, the Office Action failed to provide any evidence or explanation as to why and/or how one of ordinary skill in the art would have been motivated to modify Gross in view of Vaughn to arrive at the claimed invention. Just because Vaughn teaches overlapping printed and embossed images, which may "enhanc[e] the aesthetics" as asserted by the Examiner (or may not as this is merely an unsupported opinion), does not make it obvious to add an embossing to Gross, particularly because the Examiner failed to provide support for his assertion. There is no suggestion in either Gross or the art to provide Gross' web/film 12 with an embossing, and particularly no suggestion to provide the web/film of Gross with an embossing that ***vertically overlaps both transfer and***

printed color layers, as generally claimed. Accordingly, the Office Action's proposed combination of Gross with Vaughn is improper.

Even if it were obvious to combine Gross and Vaughn to provide Gross with an embossing, the combination would fail to arrive at the claimed invention because, contrary to the Examiner's assertion, Gross fails to disclose or suggest an overlapping transfer layer and printing. As described above, the metalized transfer layer 100 of Gross simply surrounds, ***but does not vertically overlap***, the color printed layers 32 and 50. At best, the combination would result in the substrate of Gross including the overlapping embossed image 20 and printed image 30 of Vaughn being spaced apart from Gross' metalized design 100 of the label 104 reproduced above. ***The combination would not result in all three of (1) a transfer layer, (2) a print, and (3) an embossing in overlapping vertical alignment, as generally set forth in independent Claims 1, 18, and 19***.

Furthermore, the rollers of Gross and Vaughn would destroy any embossing provided on the substrate. This argument does not contradict Applicant's own invention as the Examiner asserted because Applicant's rollers define a "printing gap" therebetween (*see* ¶ [0063], line 3) to preserve the embossing.

For the reasons set forth above, the rejection of independent Claims 1, 18, and 19 under 35 U.S.C. § 103 is improper because one skilled in the art would not have been motivated to combine the Gross and Vaughn references, the proposed combination is based on impermissible hindsight, and the combination, even if proper, fails to disclose or suggest each and every feature of independent Claims 1, 18, and 19. For example, the combination fails to disclose at least each of a transfer layer, a print, and an embossing in overlapping vertical alignment with respect to a base layer, as

generally set forth in independent Claims 1, 18, and 19. Applicant therefore respectfully requests that this Board overturn the Section 103 rejection of independent Claim 1, 18, and 19, as well as those claims dependent therefrom.

B. Combination of Gross et al. and Vaughn et al. Fails to Render Dependent Claim 2 Obvious Under 35 U.S.C. § 103

Dependent Claim 2 stands rejected under Section 103 as unpatentable over Gross and Vaughn. Dependent Claim 2 recites, "wherein prior to the embossing and the color printing, the transfer layer is adhered to the base material with the adhesive and the adhesive is dried." The Examiner acknowledged that the combination of Gross and Vaughn fails to teach these features. *See* 3-15-2011 Final Action at 7. As basis for the rejection, the Examiner asserted that the mere rearrangement of parts is not patentable and that:

> It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gross to place the adhesive application and transfer stations before the printing stations, because this would predictably allow the printing to proceed after the foil transfer, and one having ordinary skill in the art may desire to take advantage of the aesthetic effects that would result[], such as, for example, the effect of printing on top of the transferred foil leaf.

See 3-15-2011 Final Action at 7.

The proposed modification of Gross is improper because it is based on impermissible hindsight and the Examiner failed to point to any suggestion in the art to support the desirability of the modification. *In re Mills*, 221 U.S.P.Q. 1125 (Fed. Cir. 1990). Even if it were possible to rearrange the adhesive and roll leaf transfer stations before the printing stations to provide different aesthetic effects, this is insufficient basis

to support an obviousness rejection, particularly because the Examiner failed to assert that the "aesthetic effects" are an improvement or more desirable. *Id.*

Even if it were obvious to modify Gross as the Examiner asserted, the modification fails to render the claimed invention obvious because ***the Examiner did not address the claimed "embossing."*** Because Gross fails to disclose or suggest embossing and the Examiner did not address this feature in his rejection of Claim 2, the Examiner failed to establish a *prima facie* rejection of Claim 2.

The proposed modification is also improper because it is not supported by the art. Gross is limited to performing roll leaf transfer last (after printing) and Vaughn only discloses embossing first (prior to printing). Thus, the proposed combination would merely result in embossing, followed by printing, followed by roll leaf transfer. The combination fails to suggest Claim 2, which calls for film transfer prior to both embossing and color printing.

Applicant therefore respectfully requests that this Board overturn the Section 103 rejection of dependent Claim 2.

C. Combination of Gross et al. and Vaughn et al. Fails to Render Dependent Claim 20 Obvious Under 35 U.S.C. § 103

Dependent Claim 20 stands rejected under Section 103 as unpatentable over Gross and Vaughn. Dependent Claim 20 recites "wherein said base layer interacts with said film transfer device before said stamping device." The Examiner based his rejection of Claim 20 on the following: "the combination of Gross and Vaughn could result in an apparatus where the embossing is either after or before the foil transfer").

But Gross discloses performing roll leaf transfer last (after printing) and Vaughn discloses embossing first (prior to printing). Thus, even if the combination of the Gross

and Vaughn references was proper, the combination would merely result in embossing, followed by printing, followed by roll leaf transfer. The combination would not render obvious Claim 20, which calls for film transfer prior to stamping.

Applicant therefore respectfully requests that this Board overturn the Section 103 rejection of dependent Claim 20.

D. Combination of Gross et al. and Vaughn et al. Fails to Render Dependent Claim 22 Obvious Under 35 U.S.C. § 103

Dependent Claim 22 stands rejected under Section 103 as unpatentable over Gross and Vaughn. Dependent Claim 22 recites, "wherein said drying unit is between said gluing unit and said printing device." The Examiner asserted that the heating station 20 illustrated in Figure 1 of Gross is between a gluing unit and a printing device. But contrary to the Examiner's assertion, the heating station 20 is between glue printing station 18 and the roll leaf transfer station 24, not a gluing unit and a printing device as set forth in Claim 22 (Gross' printing stations 14 and 16 are "upstream" of both the glue station 18 and the roll leaf transfer station 24). The Examiner's rejection is thus based on an incorrect interpretation of the art, and the Examiner has failed to establish a prima facie case of obviousness.

Applicant therefore respectfully requests that this Board overturn the Section 103 rejection of dependent Claim 20.

E. Combination of Gross et al. and Vaughn et al. Fails to Render Dependent Claim 23 Obvious Under 35 U.S.C. § 103

Dependent Claim 23 stands rejected under Section 103 as unpatentable over Gross and Vaughn. Dependent Claim 23 recites, "wherein actively drying with the drying device completely dries the adhesive layer." As the Examiner correctly pointed out,

Gross recites the following at col. 4, line 65 to col. 5, line 1: "the heating station 20, which functions to evaporate water contained in the adhesive 68 that has been applied to the web 12, thereby drying the adhesive" But the adhesive cannot be "completely" dry as claimed because at the transfer station 24 the adhesive must be sufficiently wet to bond to the metallic layer 98 of the roll leaf 90 without the application of heat. *See* col. 5, lines 5-25. Gross thus teaches away from "completely" drying the adhesive layer as claimed because the device of Gross would not function if the adhesive was "completely" dry. Applicant therefore respectfully requests that this Board overturn the Section 103 rejection of dependent Claim 23.

F. Combination of Gross et al. and Vaughn et al. Fails to Render Dependent Claims 24 and 27 Obvious Under 35 U.S.C. § 103

Dependent Claims 24 and 27 each stand rejected under Section 103 as unpatentable over Gross and Vaughn. Dependent Claim 24 recites, "wherein the drying step includes drying with at least one of infrared radiation and ventilator blowing." Dependent Claim 27 recites, "wherein the drying unit includes one of ventilator blowing or infrared radiation."

The Office Action asserts that the heating station 20 (col. 3, lines 37-45) of Gross discloses drying with infrared radiation. But Gross fails to disclose how the heating station 20 generates heat, and fails to disclose or suggest either infrared radiation or ventilator blowing, as set forth in Claims 24 and 27. Applicant therefore respectfully requests that this Board overturn the Section 103 rejection of each of dependent Claims 24 and 27.

CONCLUSION

In view of the above discussion, Applicant believes that the pending claims are patentably distinguishable over the art cited by the Examiner. Accordingly, Applicant respectfully requests that this Board reverse the final rejection of Claims 1-3, 5, 7, 9, 18-20, 22-25, and 27-31.

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

PAYMENT

Please charge any deficiency or credit any overpayment pursuant to 37 C.F.R. § 1.16, § 1.17 or § 41.20 to Deposit Account No. 08-0750.

Dated: July 25, 2011

Respectfully submitted,

/G. Gregory Schivley/
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APPENDIX A - CLAIMS

Claims Involved in the Appeal of Application Serial No. 10/579,278.

1. (Previously Presented) A method for the production of print products by combining various immediately successive processing methods, the method comprising the steps of:

partially coating less than an entirety of a base material with an adhesive at predetermined positions of the base material corresponding to intended locations of the print products;

providing a transfer film including a carrier foil layer, a parting layer, and a transfer layer;

removing said transfer layer from said carrier foil and transferring less than an entirety of the transfer layer to the base material exclusively at the predetermined positions of the base layer by adhering the transfer layer to the adhesive;

providing an embossing at the predetermined positions of the base material;

providing a color printing at the predetermined positions of the base material one of before or after coating the base material with an adhesive; and

actively drying with a drying device one of the adhesive or the color printing;

wherein the print products to be produced successively undergo the steps of the method in one continuous sequence without intermediate storage; and

wherein at each predetermined position on the substrate the transferred portion of the transfer layer, the color printing, and the embossing overlap and are positioned in stacked vertical alignment with respect to the base material.

2. (Previously Presented) The method according to claim 1, wherein prior to the embossing and the color printing, the transfer layer is adhered to the base material with the adhesive and the adhesive is dried.

3. (Previously Presented) The method according to claim 1, wherein ~~the~~ after the embossing and color printing, the color printing is dried and the transfer layer is transferred to the base material with the adhesive.

4. (Cancelled)

5. (Previously Presented) The method according to claim 1, wherein the color printing is provided one of before or after the embossing.

6. (Cancelled)

7. (Previously Presented) The method according to claim 1, wherein the transfer film is stretched in the direction of width.

8. (Cancelled)

9. (Previously Presented) The method according to claim 1, further comprising pressing the transfer layer onto the base material using a pressing unit.

10. – 17. (Cancelled)

18. (Previously Presented) A method for producing a print product, said method comprising:

coating a base layer with an adhesive layer exclusively at predetermined positions of the base layer corresponding to desired locations of the print products;

providing a transfer film including at least a carrier foil layer, a parting layer, and a transfer layer;

transferring portions of the transfer layer to said base layer exclusively at the predetermined positions including the adhesive;

embossing the base layer at the predetermined positions of the base layer one of before or after coating the base layer with the adhesive layer;

printing the base layer with a print at the predetermined positions of the base layer one of before or after coating the base layer with the adhesive layer; and

actively drying one of the adhesive or the print in a drying unit;

wherein the method is performed successively and continuously without intermediate storage; and

wherein at each predetermined position the adhesive, the transfer layer, the print, and the embossing are in overlapping, vertical alignment with respect to the base layer.

19. (Previously Presented) A combined in-line printing apparatus comprising:

a gluing unit configured to selectively apply an adhesive to a plurality of predetermined positions of a base printing material fed through said printing apparatus, each one of the predetermined positions corresponding to a desired location of a print product on the base printing material;

a stamping device configured to form a pattern in said base material exclusively at each of the predetermined positions, the pattern including at least one of elevations or indentations;

a film transfer device configured to transfer a transfer layer of a transfer film to said base material exclusively at the predetermined positions to which the adhesive has been previously applied, said transfer film having at least a carrier foil layer, a parting layer, and said transfer layer;

a printing device configured to print a material exclusively at the predetermined positions of said base material;

a drying unit configured to actively dry said adhesive; and

a pressing unit having a plurality of calenders configured to compress said base layer and said transfer layer;

wherein said base layer interacts with said gluing unit, said stamping device, said film transfer device, and said printing device without intermediate storage to

provide the adhesive, the transfer film, the pattern, and the print material in overlapping vertical alignment on the base printing material at each of the predetermined portions.

20. (Previously Presented) The combined in-line printing apparatus of claim 19 wherein said base layer interacts with said film transfer device before said stamping device.

21. (Cancelled)

22. (Previously Presented) The combined in-line printing apparatus of claim 19, wherein said drying unit is between said gluing unit and said printing device.

23. (Previously Presented) The method of claim 1, wherein actively drying with the drying device completely dries the adhesive layer.

24. (Previously Presented) The method of claim 1, wherein the drying step includes drying with at least one of infrared radiation and ventilator blowing.

25. (Previously Presented) The method of claim 1, wherein the drying device includes a first part on a first side of the print products and a second part on a second side of the print products that is opposite to the first side.

26. (Cancelled)

27. (Previously Presented) The combined in-line printing apparatus of claim 19, wherein the drying unit includes one of ventilator blowing or infrared radiation.

28. (Previously Presented) The combined in-line printing apparatus of claim 22, wherein the drying unit is one of upstream or downstream from the gluing unit.

29. (Previously Presented) The method of claim 1, wherein at each predetermined position on the substrate the transferred portion of the transfer layer, the color printing, and the embossing are provided with the same design pattern.

30. (Previously Presented) The method of claim 18, wherein at each predetermined position the transfer layer, the print, and the embossing have the same design pattern.

31. (Previously Presented) The combined in-line printing apparatus of claim 19, wherein the transfer film, the pattern formed by the stamping device, and the print material each include the same design pattern.

APPENDIX B - EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted.

APPENDIX C – RELATED PROCEEDINGS

No related proceedings are referenced in Section II above, hence copies of decisions in related proceedings are not provided.

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